

In re Appln. of VERSCHUEREN et al.
Application No. 10/068,312

REMARKS

Reconsideration of the above-identified application is respectfully requested in view of the following remarks.

The Pending Claims

Claims 1, 2, 4 and 6-14 are currently pending. Each claim is directed to a method of lithographic printing.

Summary of the Office Action

Claims 1, 2, 6-8 and 11-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Teng (i.e., U.S. Patent 6,482,571) in view of Bailey et al. (i.e., U.S. Patent 6,040,115) and Moss et al. (i.e., EP 640,478). Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Teng in view of Bailey et al., Moss et al., and further in view of Vermeersch et al. (EP 770,494). Claim 5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Teng in view of Bailey et al., Moss et al., and further in view of Vermeersch '128 (i.e., U.S. Patent 5,786,128). Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Teng in view of Bailey et al., Moss et al., and further in view of Kingman et al. (i.e., U.S. Patent 6,140,392). Claim 15 is objected to as being a substantial duplicate of claim 7.

Discussion of the Obviousness Rejections

(a) Claims 1, 2, 6-8 and 11-15

The Office Action has rejected claims 1, 2, 6-8 and 11-15 under 35 U.S.C. § 103(a) as allegedly obvious in view of and, therefore, unpatentable over Teng in view of Bailey et al. and Moss. As applicants have incorporated the substance of claims 3 and 5 into independent claim 1, this rejection is rendered moot. Withdrawal of this rejection is respectfully requested.

(b) Claims 3-5

The Office Action rejected claims 3 and 4 under 35 U.S.C. § 103(a) as allegedly obvious in view of and, therefore, unpatentable over Teng in view of Bailey et al. and Moss, and further in view of '494 Vermeersch et al. Claim 5 was also rejected as allegedly obvious

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in view of and, therefore, unpatentable over Teng in view of Bailey et al. and Moss, but in further view of Vermeersch et al. '128.

As claim 4 is canceled, the rejection of this claim is now moot. The remaining claim rejections are based on the combination of Teng with three other prior art references. Applicants respectfully disagree that the references may properly be combined in the manner suggested in the Office Action.

The claimed method, among other limitations, contemplates applying on a lithographic base an image-recording layer comprising hydrophilic thermoplastic particles or an aryldiazosulfonate polymer which is removable in a single-fluid ink or can be rendered removable in a single-fluid ink by exposure to heat or light; processing the image-recording layer by supplying single-fluid ink, thereby obtaining a printing master; and printing by supplying single-fluid ink to the printing master which is mounted on a plate cylinder of the printing press.

The Office Action contends that although Teng does not teach an image-recording layer of the claimed composition, the compositions disclosed in either Vermeersch et al. '128 or Vermeersch et al. '494 could be substituted for that set forth in Teng, rendering claims 3 and 5 (now claim 1) unpatentable.

Applicants submit that the Teng disclosure does not justify the broad teaching attributed to this reference by the Office Action. One reading Teng would understand that the on-press processing of plates using single fluid inks is not applicable to any plate type, but is limited solely to the specific plate types described in Teng: "[t]he recently introduced single fluid ink by Flink [sic-Flint] Ink Company, which can be used for printing wet lithographic plate without the use of fountain solution, can also be used for the on-press development and printing of the plate of this invention." *See, e.g., col. 9, lines 55-59 (emphasis added)*. The Teng plates are restricted to those having a thermosensitive layer capable of hardening or solubilization upon exposure to an infrared radiation, and its teaching is limited to those plates due to the absence of any suggestion in Teng itself that the process could successfully be used on other plate types. *See, e.g., col. 4, lines 31-35*. That Teng does not negate the use of the process in other plate types is insufficient to support the rejection—silence cannot provide a teaching or suggestion. There must be a passage in the reference itself that affirmatively sets forth the teaching or suggestion relied upon in the Office Action. Absent

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this, extending the teaching of a reference to technologies not described or mentioned in the reference itself is improper. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure." *See MPEP § 706.02(j)*.

The technologies disclosed in Vermeersch '494 and '128, relative to Teng, are wholly distinct, and are not properly combinable with Teng. Unlike Teng, Vermeersch '494 uses polymers in its imaging layer, *see, e.g., col. 2, line 44*, and there is no teaching or suggestion to use any polymerizable materials in its imaging layer. Vermeersch et al. '128 uses an aryldiazosulfonate polymer (a opposed to a polymerizable material) in its imaging layer. Teng, on the other hand, uses polymerizable materials, such as monomers, *See, e.g., col. 6, line 9*, and there is no teaching or suggestion to use polymers in its imaging layer.

Since, the two Vermeersch technologies are distinct from Teng, and there is nothing in the references themselves that supports their combination (as discussed in a prior paragraph concerning the narrow teaching set forth in Teng), the rejection should be withdrawn.

The addition of Moss et al. fails to provide the aforementioned teaching absent from Vermeersch et al. '494 or '128 and Teng.

Based on the foregoing, the present invention cannot be said to be unpatentable. Applicants respectfully request withdrawal of this rejection.

(c) Claims 9 and 10

The Office Action has rejected claims 9 and 10 under 35 U.S.C. § 103(a) as allegedly being obvious in view of and, therefore, unpatentable over Teng in view of Bailey et al., Moss et al, and further in view of Kingman et al.

Applicants incorporate by reference the arguments in favor of patentability set forth in section (a) above. The Office contends that the teaching of Kingman et al. is directed to certain inks. However, even assuming this teaching is provided, it fails to overcome the deficiencies in the references identified in section (a) above. Withdrawal of the rejection based on these arguments is respectfully requested.

Moreover, and based upon claim 1 as presently pending, there is no basis in the references themselves to support the alleged combination. The Kingman fluid is comprised


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of continuous ink and a non-aqueous polar solvent. However, there is no teaching in Vermeersch et al. '128 or '494 that the Kingman fluid would work in either Vermeersch et al. system (which the Office Action contends can be used in the Teng plates). In contrast to Kingman et al., Vermeersch et al. '128 prefers water as a developing fluid, *see, e.g., col. 8, ll. 32-38*, with Vermeersch et al. '494 also preferring aqueous liquids. *See, e.g., col. 8*. The use of the Kingman fluid, which is not water *per se* (and which would also not be categorized as an aqueous liquid), would directly conflict with the teaching in the Vermeersch et al. patents. Because there is no motivation in the references themselves to use the non-aqueous Kingman fluid in connection with the Vermeersch et al. '128 or '494 systems, the obviousness rejection entered against claims 9 and 10 is improper, and should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


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